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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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HEWLETT-PACKARD COMPANY
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EXAMINER

NGUYEN, NGA B

ART UNIT PAPER NUMBER

3628

DATE MAILED: 07/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/933,954

Applicant(s)

PARRY ET AL.

Examiner

Nga B. Nguyen

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MLG

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This Office Action is the answer to the communication filed on August 21, 2004, which paper has been placed of record in the file.
2. Claims 1-28 are pending in this application.

Specification

3. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code (see Specification page 4, line 19). Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-3 and 7-12 are rejected under 35 U.S.C 101 because the claimed invention is directed to non-statutory subject matter, particularly, an abstract idea.

The claims, as presently claimed and best understood were reconsidered in light of the "Examination Guidelines for Computer-Related Inventions" and were found to be non-statutory. Discussion of the analysis of the claims under the guidelines follows.

Claims 1-3 and 7-12 merely manipulate an abstract idea that is not within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of

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nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter.

As to claims 1-3 and 7-12, the invention is not implemented on a specific apparatus; therefore, the invention is not directed to the technological arts. To be statutory, the utility of an invention must be within the technological arts. The definition of "technology" is the "application of science and engineering to the development of machines and procedures in order to enhance or improve human conditions, or at least to improve human efficiency in some respect." (Computer Dictionary 384 (Microsoft Press, 2d ed. 1994)). When one looks to the present specification to determine what the applicant has invented, the invention appears to be a series of steps performed on a computer. It is clear that claims 1-3 and 7-12 are intended to be directed to the abstract method apart from the apparatus for performing the method. Therefore, claims 1-3 and 7-12 are non-statutory, because they are directed solely to an abstract idea without practical application in the technological arts.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 2, 4-7, 13-15, 21, and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Barzilai et al (hereinafter Barzilai), U.S. Patent No. 6,012,045.

Regarding to claim 1, Barzilai discloses a method for facilitating the on-line auction of one or more services, the method comprising:

obtaining a service item for auction (figure 1 and column 4, lines 19-23; computer system 20 includes merchandise data base 38 stored services for auction);

managing an on-line auction for the service item, wherein the managing comprises:

receiving on-line bids for the service item (column 5, lines 63-67; the customer places one or more bids on a service);

closing the on-line auction for the service item (column 10, lines 58-67);

indicating one or more winning bids and one or more winning bidders (column 14, lines 35-40; confirming the sale of service with the winning bidders).

Regarding to claim 2, Barzilai discloses receiving compensation from one or more members of a group selected from an auction bidder, an auction participant, a service seller, a service buyer, a service item placer, and a member of an auction (column 6, lines 27-36; receiving compensation from bidder).

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Regarding to claim 4, Barzilai discloses providing one or more computing systems that perform the obtaining and managing (figure 1; column 3, line 65-column 4, lines 37; computer system 20, computer system 62).

Regarding to claims 5-6, Barzilai discloses wherein the obtaining and managing further comprises receiving information related to the service item and real-time bids for the service item via communications network (column 4, line 55-column 5, line 17; the network is the Internet).

Regarding to claim 7, Barzilai discloses wherein the service item is a service (column 4, lines 21-23; merchandise refers to both products and services).

Regarding to claims 13-15, Barzilai discloses an on-line marketplace for auctioning services, the marketplace comprising:

- a services auction-block computing system configured to obtain a service item which a service for auction (figure 1 and column 4, lines 19-23; computer system 20 includes merchandise data base 38 stored services for auction);

- an auctioneer computing system configured to manage an on-line auction for the service item (figure 1 and column 4, lines 24-37; call center computer system 62), wherein the managing comprises:

- receiving on-line bids for the service item (column 5, lines 63-67; the customer places one or more bids on a service);

- closing the on-line auction for the service item (column 10, lines 58-67);

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indicating one or more winning bids and one or more winning bidders (column 14, lines 35-40; confirming the sale of service with the winning bidders).

Claims 21, 23 are written in computer software that parallel the limitations found in claim 1, 7 above, therefore, are rejected by the same rationale.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 3, 10, 18, 22, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barzilai et al (hereinafter Barzilai), U.S. Patent No. 6,012,045, in view of Faber et al (hereinafter Faber), U.S. Patent No. 6,519,570.

Regarding to claims 3, 10, Barzilai does not disclose facilitating real-time provision of the service item for the one or more winning bidder, wherein the real-time provision of the service item occurs proximally near in time to the closing, wherein the service item is a proximity-independent service that is intended to be performed for the one or more winning bidders. However, Faber discloses facilitating real-time provision of the service item for the one or more winning bidder, wherein the real-time provision of the service item occurs proximally near in time to the closing, wherein the service item is a proximity-independent service

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that is intended to be performed for the one or more winning bidders (column 6, lines 1-65; column 7, line 53-column 8, line 32; customer establishes a real-time communication with the service provider right after the customer won the auction). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Barzilai's to include a proximity-independent service taught by Faber's in Barzilai's merchandise for the purpose of providing the ability for the consumer to obtain the service from the service provider, and the service provider can maximize the rate he/she can collect from the customer.

Claims 18, 22, 26 have similar limitations found in claims 3, 10 above, therefore, are rejected by the same rational.

10. Claims 8, 9, 11, 12, 16, 17, 19, 20, 24, 25, 27, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barzilai et al (hereinafter Barzilai), U.S. Patent No. 6,012,045, in view of Eldering, U.S. Patent No. 6,324,519.

Regarding to claims 8, 9, 11, 12, Barzilai does not disclose wherein the service item is a proximity-independent service, that is intended to be performed by the one or more winning bidders, selected from a group consisting of: advertising; advertising in movie houses; advertising in broadcast media; advertising on the radio; advertising on television; advertising on an Internet Web site; advertising in printed publications; Web page design; patent application drafting; brokerage and financial services; shipping; graphic design; computer programming; legal services; Internet access service; Internet Web page hosting; Internet domain name hosting; Internet E-mail hosting; Internet data storage

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hosting. However, Eldering discloses wherein the service item is a proximity-independent service, that is intended to be performed by the one or more winning bidders, that includes advertising on the radio; advertising on television; advertising on an Internet Web site; advertising in printed publications (see abstract and column 10, lines 37-60; the advertisers (bidders) place bids for the advertisement opportunity to the content provider; the advertisement which is performed by the winning advertiser is delivered to the consumer). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Barzilai's to include a proximity-independent service taught by Eldering's in Barzilai's merchandise for the purpose of providing the ability for the service provider to deliver the service to the user in order to maximize the revenue for the service provider.

Claims 16, 17, 19, 20 have similar limitations found in claims 8, 9, 11, 12 above, therefore, are rejected by the same rational.

Claims 24, 25, 27, 28 are written in computer software that parallel the limitations found in claims 8, 9, 11, 12 above, therefore, are rejected by the same rational.

Conclusion

11. Claims 1-28 are rejected.

12. The prior arts made of record and not relied upon is considered pertinent to applicant's disclosure:

Feezell et al. (US 6,253,189) disclose a system and method for completing advertising time slot transactions.

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13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Nga B. Nguyen whose telephone number is (703) 306-2901. The examiner can normally be reached on Monday-Thursday from 9:00AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough can be reached on (703) 308-0505.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 306-1113.

14. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
C/o Technology Center 3600
Washington, DC 20231

Or faxed to:

(703) 872-9326 (for formal communication intended for entry),

or

(703) 308-3691 (for informal or draft communication, please label "PROPOSED" or "DRAFT").

Hand-delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, Seventh Floor (Receptionist).

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Nga B. Nguyen

Nga Nguyen

July 21, 2004